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REMARKS

Claims 1 to 4, 7, 9, 10, 12, 13, 15, 17, 19 to 23, 25 to 32, 34 and 35 are pending in this application. Each of these claims are rejected in light of the instant, non-final, Office Action. Claim 35 is being amended herein for non-statutory reasons and is non-narrowing. It is not believed that any fees are due with this Response, however, please charge deposit account No. 02-1818 for any payment deemed necessary.

Claims 1 to 4, 7, 9 and 10, 12 and 13, 15, 17, 19 to 23, 25 to 32 and 34 to 35 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,823,873 to Moody ("Moody"). As an initial note, Applicants wish to clarify for the record that while the finality of the previous Office Action has been removed, the Examiner has entered the amendments and claim cancellations made in response to the paper No. 10, the Final Office Action of May 30, 2002. In that Response, Applicants made amendments and presented arguments to specifically overcome the references used in the May 30, 2002, Office Action. Applicants assume at this point that the amendments and arguments were sufficient to place the claims in allowance with respect to the references cited in that Office Action. Accordingly, it is assumed that if Applicants overcome the rejection based one Moody, the claims listed above should each be in condition for formal allowance.

Claim 35 is being amended to clarify that awards are provided for "award yielding" symbol combinations rather than for any symbol combination. "Award yielding" is previously stated in the Claim, so no antecedent basis problems are produced by the amendment. The amendment eliminates the possibility that another element is added using "symbol combinations" (inferring all symbol combinations) rather than using the previously defined "award yielding symbol combinations". Applicants respectfully assert that eliminating the possibility of an additional element is broadening if anything and certainly non-narrowing.

Applicants respectfully traverse the anticipation rejection based on Moody. To summarize Applicants' arguments, which are described in detail below, Moody fails to disclose, teach or even suggest one of the main functions of the present invention, which appears in each independent claim, namely, to provide a dual evaluation of a set of symbols. The dual evaluation of the present invention takes place once upon

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generating the set of symbols, wherein the player is rewarded for generating an award winning symbol or symbol combination. Thereafter, at least some but not all of the symbols of the set are changed or modified, wherein a second evaluation takes place and the player is rewarded again for any winning symbol or combination that appears in the second or modified set of symbols. *Moody* simply does not disclose this game.

Moody discloses many different embodiments, which can be summarized as variations on the known games of stud poker and draw poker. *Moody*, in one embodiment, discloses a stud poker game operating side by side with a draw poker game. This is not the same as providing a first set of symbols, paying for any combination of the first set of symbols, modifying the first set to produce a second set of symbols and paying the player for any winning combination in the second set.

In particular, Figs. 1 to 3 of *Moody* disclose a stud poker game indicated by line 20 operating along side a draw poker game indicated by line 40. In Figs. 1 to 3, *Moody* provides two sets of symbols, modifies one of the sets of symbols, and then evaluates the one set as modified and the other set as unmodified, i.e., one set as a draw poker game and the other set as a stud poker game, respectively. Even though symbols taken from the stud poker line 20 are employed in the draw poker line 40, *Moody* does not disclose the limitations of the present invention. Figs. 1 to 3 of *Moody* do not disclose or suggest paying the player for any winning symbols or combinations on the stud line 20, modifying the stud line 20, and then paying for a new set of symbols generated along the modified line 20.

Figs. 4 to 16 in *Moody* illustrate the "Version II" or Super Poker games of *Moody*. Specifically, Figs. 4 to 16 illustrate games 2A to 2G. Each of these games is a draw poker type game, wherein the player is paid for a combination of symbols that appear after an initial set of symbols is modified to include a new set of symbols. Thus, the Version II embodiments 2A to 2G are even further removed from Applicants' claimed invention than are the initial embodiments disclosed in connection with Figs. 1 to 3 of *Moody*. Of course, in draw poker the player can choose to keep the initially dealt hand, in which case the game pays the player for the symbols as unmodified. In this case, however, the game does not perform a second evaluation after the player decides to

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keep each of the initially dealt cards. Embodiments 2A to 2G of *Moody* do not therefore teach or suggest the claims of the present invention.

Versions 2I and 2J of *Moody* are not illustrated by the figures. Version 2I involves dealing three separate hands to the player face up. The player sees each card dealt and determines in each hand which cards to hold and which to discard. After making the selection, the player hits a "deal" button and the game evaluates each row simultaneously. Here again, *Moody* does <u>not</u> disclose dealing the player hands of cards, awarding the player for any winning combinations appearing on the originally dealt hands, allowing the player to then keep or discard a number of cards in the hands, and then awarding the player again based on the combination appearing in the modified hands.

Version 2J involves dealing five rows of cards, wherein the center row is face up. Each of the horizontal five rows is played in draw poker fashion. Since five rows of five cards a dealt, five vertical hands are formed additionally. Wherever a column of cards is left unchanged, *Moody* contemplates evaluating same on a stud poker basis. In sum, horizontally dealt hands are evaluated on a draw poker basis while certain vertically disposed cards may be evaluated on a stud poker basis. This is simply another way to combine a stud poker game that is evaluated simultaneously with a draw poker game.

After the Version II games, *Moody* continues on and discloses combining concepts of *Moody* with CARIBBEAN STUD POKER ®, LET IT RIDE ® and Texas Hold 'Em. Each of these combinations, as above, involves playing multiple poker games at once. *Moody* then discloses a game that combines Twenty-one with stud poker. In this embodiment, cards that are dealt either to the dealer or the player for Twenty-one are evaluated afterward for a stud poker payout. For the same reasons discussed above, none of these embodiments disclose or suggest the limitations of the present invention.

Turning now the claims of the present invention, Claim 1 is directed to a method for operating a slot machine having a plurality of symbols. The method comprises the steps of: (i) maintaining a list of award yielding symbol combinations; (ii) randomly generating on a plurality of paylines a first set of the symbols from the plurality of symbols; (iii) providing an award for each award yielding symbol combination appearing in the first set; (iv) selecting at least one but not all of the symbols in the first set for

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individual replacement and replacing each selected symbol in the first set with one of the plurality of symbols to generate the second set of symbols; and (v) providing an award for each award yielding symbol combination appearing in the second set regardless of whether the award yielding combination in the second set appears in the first set. *Moody* does not teach these steps.

Moody does not teach generating on a plurality of paylines a first set of symbols; awarding the player for each award yielding combination appearing in the first set; replacing at least one but not all of the symbols in the first set with another symbol; and awarding the player for award winning combinations appearing in the second set even if they do not appear in the first set. As discussed above, *Moody* provides the player with an opportunity to play multiple poker hands at once, either multiple draw poker hands or one or more draw poker hands in combination with stud poker. When the player in *Moody* plays a draw poker game, however, the game is played under the normal rules of draw poker, which include paying the player after, and only after, the player selects to keep all cards or discarding at least one card.

In essence, because draw poker does not teach the limitations of Claim 1, *Moody*, which merely teaches multiple draw poker games and draw poker games in combination with stud poker games, does not teach the limitations of the present invention. Accordingly, Claim 1 and 2 to 4, 7, 9, 10, 12, 13, 15, 25 and 26 that directly or indirectly depend from Claim 1 are in condition for allowance. Applicants, as stated in the previous Response of July 29, expressly maintain the right to seek broader patent protection on the subject matter of the present invention in a continuation application for each of the pending claims.

Claim 17 is directed a method for operating a game device that includes a plurality of symbols. The method includes the steps of: (i) maintaining in a controller of the gaming device, a list of award yielding symbol combinations; (ii) generating a set of symbols, wherein when one of the symbols in the set is a first wild symbol; (iii) providing an award for each award yielding symbol combination appearing in the set, wherein the wild symbol functions as one of the other symbols to maximize the award; (iv) selecting at least once but not all of the symbols in the set except for the first wild symbol for replacement and replacing each selected symbol with a second wild symbol; and (v)

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providing an award for each award yielding combination appearing in the set, wherein the wild symbols function as one of the symbols to maximize the award. *Moody* does not disclose, teach or suggest the limitations set forth in Claim 17.

For each of the reasons discussed above, *Moody* does not disclose, teach or suggest the limitations of Claim 17, namely, providing a set of symbols, awarding for winning combinations in the set of symbols, replacing at least but not all of the symbols in the set with other symbols and providing an award for winning combinations generated upon replacing the symbols. Moreover, although *Moody* mentions wild symbols at certain places, *Moody* does not teach or suggest generating a first set of symbols with a wild symbol and providing an award to the player using the wild symbol to maximize the award, and thereafter replacing another symbol in the set which is not the wild symbol with a second wild symbol and performing the second award evaluation using both wild symbols.

Moody simply does not disclose such a game. *Moody* discloses a "jokers wild" or a "deuces wild" game having wild symbols, however, there is only one evaluation which is made, regardless of whether a wild symbol is generated. Accordingly, Applicant respectfully submits that Claim 17 and Claims 19 to 22 and 27 and 28 that depend therefrom are each novel, non-obvious and patentably distinguished over *Moody* and therefore in condition for allowance.

Claim 23 is directed to a method for operating a gaming device including a plurality of playing cards. The method includes the steps of: (i) maintaining in a controller a list of award yielding playing card combinations; (ii) generating a set of playing cards, wherein one of the playing cards is a wild card; (iii) providing an award for each award yielding playing card combination appearing in the set, wherein the wild card functions as one of the cards so as to maximize the award yielding combinations in the set; (iv) selecting at least one but not of the cards in the set except for the wild card for individual replacement and individually replacing each selected playing card with another wild card; and (v) providing an award for each award yielding playing card combination in the replacement set, wherein the wild cards function as one of the playing cards to maximize the award yielding combinations. For each of the above disclosed reasons, *Moody* does not teach or suggest the limitations of Claim 23.

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As discussed above, it is possible in *Moody*, as in certain other known types of draw poker games, to generate a wild card on the initial five card deal and then generate a second wild card that replaces one of the cards that the player discards. However, draw poker and the disclosure of *Moody* only include a single evaluation, which is made after the discarded cards are replaced. *Moody* does not suggest paying the player for any winning combinations caused by the wild card in the stud hand and then paying the player again once the player discards one or more cards and receives a second wild symbol, as included in Claim 23. Applicants therefore respectfully submit that Claim 23 and Claims 29 and 30 that depend therefrom are each novel, non-obvious and patentably distinguished over *Moody* and in condition for formal allowance.

Claim 31 is directed to a method for determining an award in a slot machine including a plurality of symbols and a plurality of award yielding combinations of the symbols. The method includes the steps of: (i) randomly generating on a plurality of paylines a first set of symbols; (ii) providing a player an award for each award yielding symbol combination appearing in the first set; (iii) selecting at least one but not all of the symbols in the first set for individual replacement and individually replacing each of the selected symbols with one of the symbols; and (iv) providing an award for each award yielding combination appearing in the second set regardless of whether an award was provided for such an award yielding combination in the first set. For each of the reasons discussed above, *Moody* does not teach or suggest the limitations of Claim 31.

As stated many times above, *Moody* does not teach, for a set of symbols, providing an award before and after modifying the set. Applicants' therefore respectfully submit that Claim 31 is novel, non-obvious and patentably distinguished over *Moody* and in condition for allowance.

Claim 32 is directed to a method for operating a gaming device including a plurality of symbols and a plurality of award yielding combinations of the symbols. The method includes the steps of: (i) generating a set of symbols, wherein one of the symbols in the set is a first wild symbol; (ii) providing an award for each award yielding symbol combination appearing in the set, wherein the wild symbol functions as one of the symbols to maximize the award yielding symbol in the set; (iii) individually substituting a second wild symbol for at least one but not all of the symbols in the set

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except for the first wild symbol; and (iv) providing an award for each award yielding symbol combination appearing in the set, wherein each wild symbol functions to maximize the award. For each of the reasons discussed above, *Moody* does not teach or suggest the limitations or Claim 32.

In particular, *Moody* does not disclose awarding the player for winning combinations created before and after the modification of a set of symbols. Further, *Moody* does not disclose such a game in the context of generating a first wild symbol in the initial deal and generating a second wild symbol after replacing at least one of the symbols in the first set. Applicants therefore respectfully submit that Claim 32 is novel, non-obvious and patentably distinguished over *Moody* and in condition for allowance.

Claims 34 and 35 are each directed to gaming devices that generate a set of symbols, wherein one of the symbols is a wild symbol, providing an award for each award winning symbol combination in the set, replacing at least one non-wild symbol in the set with another wild symbol and providing an award for each award winning combination of symbols in the replaced set. For each of the reasons discussed above, *Moody* does not teach, disclose or suggest the limitations of independent Claims 34 and 35. As stated before, *Moody* does not disclose a dual evaluation, wherein an award is evaluated based on a set of symbols as originally generated and then as modified. Applicants therefore respectfully submit that Claims 34 and 35 are novel, non-obvious and patentably distinguished over the art of record.

An earnest endeavor has been made to place this application in condition for formal allowance and in the absence of more pertinent art such action is courteously solicited. If the Examiner has any questions regarding this Response, Applicants respectfully request that the Examiner contact the Applicants' attorney, Adam Masia, at (312) 807-4284 to discuss this Response.

Attached hereto is a marked-up version of the changes made to the specification and Claims by the current amendment. The attached page is captioned "**Versions with Markings to Show Changes Made.**"

Respectfully submitted,

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BELL, BOYD & LLOYD LLC

BY _____
Adam H. Masia
Reg. No. 35,602
P.O. Box 1135
Chicago, Illinois 60690-1135
Phone: (312) 807-4214

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In the Claims:

Claim 35 has been amended as follows:

35.   (Twice Amended) A gaming device comprising:

a processor;

a memory device which maintains a plurality of symbols and a plurality of award yielding symbol combinations, wherein the processor communicates with the memory device to:

generate a set of symbols, wherein one of said symbols is a wild symbol;

provide an award for each award yielding symbol combination appearing in said set, wherein said wild symbol functions as one of the symbols;

individually substitute another wild symbol for at least one but not all other non-wild symbols in said set; and

provide an award for each award yielding symbol combination appearing in said set, wherein each wild symbol functions as one of the symbols.

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